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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/059,236	01/31/2002	Katsumi Oomori	2002-0091	8980
513	7590	03/04/2004	EXAMINER	
WENDEROTH, LIND & PONACK, L.L.P.			LEE, SIN J	
2033 K STREET N. W.			ART UNIT	
SUITE 800			PAPER NUMBER	
WASHINGTON, DC 20006-1021			1752	

DATE MAILED: 03/04/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/059,236

Applicant(s)

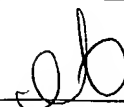
OOMORI ET AL.

Examiner

Sin J. Lee

Art Unit

1752



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 05 December 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-3 and 5-12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3 and 5-12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☒ Certified copies of the priority documents have been received in Application No. 09/291,116.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### DETAILED ACTION

1. The statement of the reference to the prior applications is acknowledged. However, the statement should be updated according to the current status of all nonprovisional parent applications referenced (the application 09/291,116 is patented (Patent No. 6,387,587 B1)).
2. Applicants canceled claim 4.
3. In view of the amendment filed on December 5, 2003 (in which present component (B) has been narrowed to an iodonium salt containing a nonafluorobutane sulfonate ion as the anion), previous rejections on claims 1-3, 5, and 9 over Barclay et al'231 in view of Padmanaban et al'128 and previous rejections on claims 6-8 and 10-12 over Barclay et al'231 in view of Padmanaban et al'128 and further in view of Ohsawa et al'218 are hereby withdrawn. Also, in view of the amendment, previous rejections on claims 1-3, 5, 6, and 9 over Yamachika et al'495 in view of Padmanaban et al'128 and previous rejections on claims 7, 11, and 12 over Yamachika et al'495 in view of Padmanaban et al'128 and further in view of Sato et al'240 are hereby withdrawn. None of those cited prior arts teaches or suggests the presently claimed *iodonium salt* containing a *nonafluorobutane sulfonate ion* as the anion.
4. Due to new grounds of rejections, the following rejections are made *non-final*.

### Double Patenting

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11

Art Unit: 1752

F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6. Claims 1-3 and 5-12 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-3, 7-9 and 11-13 of U.S. Patent No. 6,387,587 B1. Although the conflicting claims are not identical, they are not patentably distinct from each other because of the following reasons:

Claim 1 of Pat.'587 states the following:

**1. A positive-working chemical-amplification photoresist composition which comprises, as a uniform solution in an organic solvent:**

**(A) 100 parts by weight of a copolymeric resin consisting of from 50 to 85% by moles of (a) hydroxyl group-containing styrene units, from 15 to 35% by moles of (b) styrene units and from 2 to 20% by moles of (c) acrylate or methacrylate ester units each having a**

**solubility-reducing group capable of being eliminated in the presence of an acid;**

**(B) from 1 to 20 parts by weight of a radiation-sensitive acid-generating agent which is bis(4-tert-butylphenyl) iodonium nonafluorobutane sulfonate; and**

**(C) an amine compound selected from the group consisting of secondary amines and tertiary amines in an amount in the range from 0.001 to 10 parts by weight per 100 parts by weight of the component (A).**

the bis(4-tert-butylphenyl)iodonium nonafluorobutane sulfonate shown above as the component (B) is the present iodonium salt containing a nonafluorobutane sulfonate ion

Art Unit: 1752

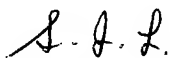
as the anion. Therefore, claim 1 of Pat.'587 renders obvious present inventions of claims 1 and 6. Claim 2 of Pat.'587 renders obvious present invention of claim 2. Claim 3 of Pat.'587 renders obvious present invention of claim 3. Claim 7 of Pat.'587 renders obvious present invention of claim 5. Since claim 8 of Pat.'587 teaches the use of a *carboxylic acid compound* in an amount in the range from 0.001 to 10 parts by weight per 100 parts by weight of the component (A), claim 8 of Pat.'587 renders obvious present invention of claim 7. Claim 11 of Pat.'587 renders obvious present invention of claim 8. Claim 12 of Pat.'587 renders obvious present invention of claim 9. Claim 13 of Pat.'587 renders obvious present invention of claim 10. Claim 9 of Pat.'587 renders obvious present invention of claim 11. With respect to present claim 12, the present claim language does not require the presence of the phosphorus-containing oxo acid compound. It only requires that *if* the component (D) of present claim 7 happens to be a phosphorus-containing oxo acid compound, *then* the phosphorus-containing oxo acid compound has to be phenylphosphonic acid. Since claim 8 of Pat.'587 teaches a carboxylic acid compound (not the phosphorus-containing oxo acid compound) as the present component (D), claim 8 of Pat.'587 still renders obvious present invention of claim 12.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sin J. Lee whose telephone number is 571-272-1333. The examiner can normally be reached on Monday-Friday from 9:00 am EST to 5:30 pm EST.

Art Unit: 1752

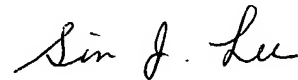
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark F. Huff, can be reached on 571-272-1385. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



S. Lee

February 26, 2004



Sin J. Lee

Patent Examiner

Technology Center 1700